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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,292	08/31/2000	Donald W. Bowden	9151-11	4240

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EXAMINER

BASI, NIRMAL SINGH

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 12/18/2001

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/652,292	Applicant(s) Bowden et al
Examiner Nirmal S. Basi	Art Unit 1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Aug 31, 2000
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: _____

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DETAILED ACTION

1. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number 5 is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

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2. ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10-11, drawn to isolated polypeptide comprising SEQ ID NO:2 or fragments and variants thereof, classified in class 530, subclass 350.
- II. Claims 1-9 and 36, drawn to the polynucleotide encoding the polypeptide of SEQ 15 ID NO:2, comprising SEQ ID NO:1 or variants and fragments thereof, vectors encoding, cells containing the afore mentioned expression vectors, classified in class 536, subclass 23.1, for example .
- III. Claims 14-15, drawn to antibody that binds to the polypeptide of claim 1, classified in class 530, subclass 387.9, for example.

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- IV. Claims 16-21, drawn to method of screening substances as modulators of mammalian glucose transporter activity, classified in class 435, subclass 7.1 for example.
- V Claims 22-28, drawn to method of screening subjects for glucose transporter disorder comprising determining GLUT 10 activity, classified in class 435, subclass 70.21, for example.
- VI. Claims 29-32, drawn to method of screening compounds for their ability to be transported across cell membrane cells, classified in class 435, subclass 7.21 for example.
- 10 VII. Claims 33-35 drawn to a method for detecting a thyroid tumor in a subject comprising detecting expression of GLUT 10 gene, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

The proteins of Invention I are related to the nucleic acids of Invention II by virtue of

15 encoding the same. The DNA molecule has utility for the recombinant production of the protein in a host cell. Although the DNA molecule and protein are related since the DNA encodes the specifically claimed protein, they are distinct inventions because they are physically and functionally distinct chemical entities, and the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the

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natural source. Further, the DNA may be used for the processes other than the production of the protein, such as nucleic acid hybridization.

The proteins of Invention I are related to antibodies of Invention III by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related due to the necessary stearic complementary of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right or in assays for the identification of agonists of the receptor protein.

The proteins Inventions I and the methods of Inventions IV-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins may be used for the production of antibodies of Invention III.

The compounds of Invention I are distinct from the methods of Invention VII wherein the compounds of Invention I can neither be used in nor made by the methods of Invention VII.

The compounds Inventions II and the method of Invention VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another

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materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids of Invention II may be used for the production of protein.

The compounds of Invention II are distinct from the methods of Invention IV-VI wherein
5 the compounds of Invention II can neither be used in nor made by the methods of Invention IV-
VI.

The compounds of Invention III are distinct from the methods of Invention IV-VII
wherein the compounds of Invention III can neither be used in nor made by the methods of
Invention IV-VII .

10 Because these inventions are distinct for the reasons given above, restriction for
examination purposes as indicated is proper. A search of the art for Inventions I-VII would not be
co-extensive with each other. Because the searches required for these inventions are not
co-extensive an examination of the materially different, patentably distinct inventions in a single
application would constitute a serious burden on the examiner.

15 Applicant is advised that the reply to this requirement to be complete must include an
election of the invention to be examined even though the requirement be traversed (37
CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the
inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently
20 named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Advisory Information

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 308-0294.

10 Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

15 Nirmal S. Basi
Art Unit 1646
December 16, 2001



YVONNE EYLER, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



RESTRICTION ELECTION FACSIMILE TRANSMISSION

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